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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,721	02/06/2002	Kiyotaka Matsuno	15252	1963

7590 07/20/2010  
Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER
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MENDOZA, MICHAEL G

ART UNIT	PAPER NUMBER
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3734

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/072,721  
Filing Date: February 06, 2002  
Appellant(s): MATSUNO ET AL.

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MATSUNO et al.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/19/2010 appealing from the Office action mailed 9/17/2009.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 73-96 are pending.

Claims 73-94 are rejected.

Claims 95 and 96 are withdrawn from consideration.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being

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maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

### **(8) Evidence Relied Upon**

5,766,189	MATSUNO	6/1998
5,499,990	SCHULKEN et al.	3-1996

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 73-84 and 87-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuno 5766189.
2. Matsuno discloses the claimed invention except for the coupling member includes a first end fastened to the distal end of the actuating wire to be immovable in an axial direction of the actuating wire and a direction deviating from the axial direction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the coupling member immovable in an axial direction of the actuating wire and a direction deviating from the axial direction by making the coupling member and actuating wire once piece, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together

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involved only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

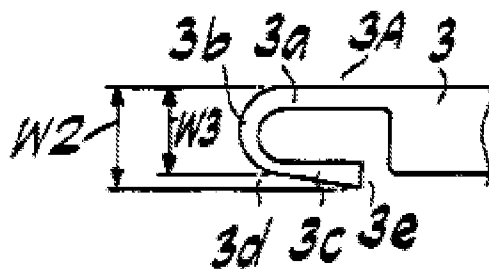
3. Matsuno fails to teach wherein the operation wire and coupling member are connected to each other by press working, wherein the operation wire and coupling member are connected to each other by a hole and hook, wherein the operation wire and coupling member are connected to each other by caulking, or wherein the operation wire and coupling member are connected to each other by welding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the wire and coupling member as recited in the claims because the particulars of the connection are a mere design choice. Furthermore, the Applicant has not disclosed why the particulars of the operation wire are of importance or solve a stated problem or provide an advantage over the prior art.

4. Furthermore, claims 73, 75-80, 89, and 92-94 are product-by-process claims. A product-by-process claim is not limited to the manipulation of the recited step, only the structure implied by the step. The claimed product appears to be the same or similar to that of the prior art.

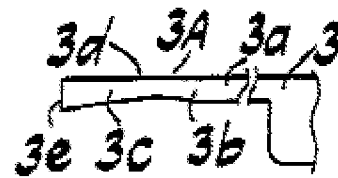
5. As to claims 73-84 and 87-94, Matsuno teaches a disposable clipping device for clipping tissue in the body of a patient comprising: a sheath member; an actuating wire; a coupling member; a clip unit having a tissue clip; and when applying the tissue clip, the second end of the coupling member is deformable upon exertion of a force in a proximal direction at the first end of the coupling member that is greater than a predetermined amount so as to prevent subsequent attachment of the second end to

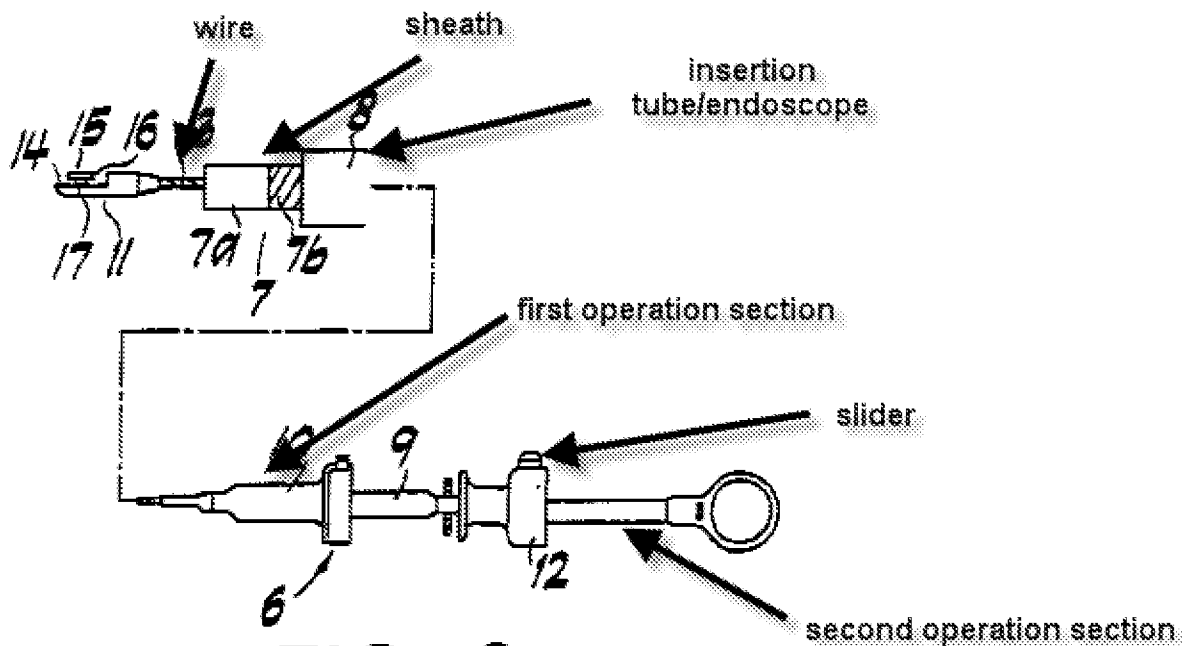
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another clip the clip clips tissue; an insertion tube that is fitted over the sheath member and movable longitudinally relative to the same; a first operation unit mounted in the area of the proximal end of the insertion tube, as well as a second operation unit for exercising a pulling action on the actuation wire, wherein the second operation unit is provided with a slider that is coupled to the proximal end of the actuating wire; and wherein the insertion tube is provided with raised portions at its inner surface and/or its outer surface.

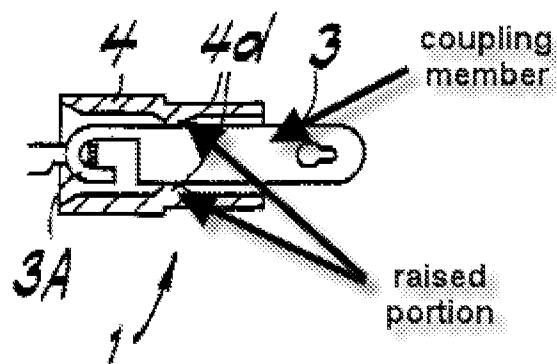
**FIG. 2A**

force required to straighten, not  
reusable

**FIG. 2B**



**FIG. 3**



**FIG. 9A**

6. As to claim 87, Matsuno teaches the clipping device of claims 55, 61, and 67. It should be noted that Matsuno fails to teach wherein the clipping device is arranged in a packing unit. However, it is well known in the art of disposable surgical devices to pack the devices to maintain sterility. Therefore it would have been obvious to one having

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ordinary skill in the art at the time the invention was made to pack the device to maintain the sterility of the device before use.

7. Claims 85 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuno as applied to claim 73 above, and further in view of Schulken et al. 5499990.

8. Matsuno teaches the clipping device of claim 73. It should be noted that Matsuno fails to teach a lubricant disposed on an outer surface of the actuating wire.

9. Schulken et al. teaches the use of lubricant to reduce friction (col. 4, lines 42-46). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Matsuno to include the use of lubricant in view of Schulken et al. to reduce friction between the wire and sheath to facilitate easier operation of the device.

#### **(10) Response to Argument**

In the appeal brief the appellant merely states the differences between the patent and the application claims. The difference being the coupling plate of Matsuno being detachable from the actuating wire. The forming of the coupling member and actuation wire into one piece would meet the requirements of the claim. Appellant recites the purported merits of the instant invention, but has provided no evidence that such advantages are unpredictable or unexpected. The appellant further recites the claim limitations and concludes by stating the claims read over the Matsuno reference. Appellant has not distinctly and specifically pointed out the errors in the 35 U.S.C. 103(a) rejections of claims 73-84 and 87-94.



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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael G. Mendoza  
/Michael G. Mendoza/  
Examiner, Art Unit 3734

Conferees:  
Todd Manahan  
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